

Appl. No. : 09/881,142
Filed : June 14, 2001

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REMARKS

Applicant has the following comments with respect to the Office Action that was mailed on November 15, 2006.

Discussion of Claim Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1-3, 5-20, 22-26, 28-31, 33-44, 48, 49, 53, 54, 58, 59, 63, and 64 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,543,851, to Chang (hereinafter "Chang") in view of U.S. Patent No. 5,543,851, to Dey, et al. (hereinafter "Dey"). Claims 45-47, 50-52, 55-57, and 60-62 were rejected as being unpatentable over Chang and Dey and further in view of U.S. Patent No. 6,097,442, to Rumreich, et al. (hereinafter "Rumreich"). Applicant respectfully traverses these rejections.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art references must teach or suggest all the claim limitations. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited references fail to teach or suggest in isolation and in combination at least one limitation from each of the above-listed claims. Furthermore, Applicant respectfully submits that there is no teaching or suggestion to combine the references as suggested by the Examiner.

One embodiment described in the application includes an electronic device that is configured to receive closed caption information. Using an input device, such as a remote control, a user can maintain the close caption information on a display associated with the electronic device. Further the user may *select* one or more words of the maintained text for transmission over a network to a remote shared database system. Turning to the claims it is seen that independent Claim 1, recites "receiving, via the input device, the third control instructions to *select* at least one of the symbols; highlighting the selected symbols on the display; and transmitting, via a network, the *selected* symbols to a shared database system that is external to the display." Independent Claims 3, 7, 20, and 31, each recite similar types of limitations.

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Applicant respectfully submits that the cited references do not teach in isolation or in combination at least the foregoing limitation. Chang is generally directed to a translation utility that allows a user to display translations of closed caption information. *See, e.g., Chang*, Figure 7b. Chang does not retrieve information from a remote database system nor does it retrieve information over a network as is claimed. Applicant also respectfully submits that Chang does not teach or suggest using a shared database.

Furthermore, Applicant respectfully submits that at least these limitations are not taught or suggested by Dey. Dey is generally directed to a system for retrieving documents that relate to a particular *temporal portion* of an audio visual sequence. In fact, Dey, the information that is searched upon is never displayed or identified to the user. In Dey, subsequent to a user identifying an interest in a particular portion of an audio sequence, the system retrieves all documents relating to a predefined window of time, e.g., 30 seconds from a signal from a user. *See Dey*, col. 9, line 44 - col. 10, line 45. Thus, Dey provides a solution to allow a user to retrieve information about a particular audiovisual segment—not however, a way for a user to retrieve information about a particular user-selected word or phrase—even if that word or phrase has been viewed and mentally identified as of interest by the user.

In the Office Action, the Examiner acknowledged that Chang “fails to specifically disclose transmitting, via a network the selected symbols to a shared database system that is external to the display” (*see Office Action*, p. 3) but took the position that such feature was described in Dey. Applicant respectfully disagrees that Dey teaches this limitation. As discussed above, Dey wholly fails to teach or suggest transmitting user-selected words or phrases to a database system. Dey does not allow a user to select particular words or phrases of closed caption information--instead, the Dey system automatically determines a set of words based upon a temporal window about a user-initiated signal. Thus, Applicant respectfully submits that each of the cited references fails to teach or suggest at least the limitation of transmitting user-selected symbols to a shared database system. In view that each of the cited references fails to teach or suggest a particular limitation in isolation or in combination, Applicant respectfully submits that the claims are in condition of allowance over the cited references.

Furthermore, Applicant respectfully submits that there is no teaching or suggestion to modify Chang and Dey with the disparate features suggested by the Examiner in order to derive

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the presently claimed invention. In the Office Action, the Examiner took the position that "it would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to modify Chang's system to include transmitting, via a network, the selected symbols to a shared database system that is external to the display as taught by Dey, for the typical benefit of providing a user with immediate access to additional content related to the current broadcast."

In response, Applicant submits that this finding does not support a *prima facie* rejection. Applicant respectfully submits that the Examiner can satisfy the burden of showing obviousness of the combination or modification "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). The fact that references can be modified is not sufficient to establish *prima facie* obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. *Id.* In this case, Applicant respectfully submits that the Examiner has merely made conclusory findings regarding the motivation to modify the Chang system.

Chang and Dey are each directed to solving different problems, i.e., Chang is generally directed to providing translation information and, in contrast, Dey is generally directed to how to generate a plurality of keyword search terms for related documents in response to a user signal identifying a temporal portion of the video. There is no teaching or suggestion in either reference hinting that the functionality described in the one reference could beneficially be included in the other. Applicant respectfully submits that it is improper to use the claims as a blueprint when determining whether there would have been motivation in the prior art to combine references in a selected fashion. Applicant respectfully submits that the Examiner has selectively picked items from the prior art in hindsight using the benefit of Applicant's claims. Applicant respectfully submits that there are innumerable features of different systems that *could* be incorporated into the Chang system; however, such supposition does not support that one of ordinary skill in the art *would* be motivated to include such features. Here, there is no common problem or solution

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amongst the cited references that would motivate their combination in the way suggested by the Examiner.

Furthermore, Applicant respectfully submits that with respect to Claims 45-47, 50-52, 55-57, and 60-62, there is no motivation or suggest in Chang and/or Dey to incorporate the teachings of Rumreich to derive the claimed invention. In the Office Action, the Examiner acknowledged that Chang and Dey fail to describe formatting symbols but took the position that this feature is described by Rumreich. In response, Applicant respectfully submits that Rumreich fails to teach or suggest formatting for the purpose as is recited in these respective claims, i.e., for formatting the closed caption information for transmission to a shared database system.

Rumreich is generally directed to improved ways of processing closed caption information for usage in picture-in-picture displays. *See e.g.*, Rumreich, col. 2, lines 50-62. In contrast, Applicant notes that Claims 45-47, 50-52, 55-57, and 60-62 are each recite: "formatting the selected symbols for transmission to the shared database system." In view that that closed caption information in Rumreich is being formatted for picture-in-picture display on a television, Applicant respectfully submits that the closed caption information would be formatted in a totally different way than would be done as in the claimed invention with respect to transmitting the selected and formatted text to a shared database system. In Rumreich, the system analyzes the control codes to determine when to insert carriage returns in the caption information. *See* Rumreich, col. 5, lines 35-38. In contrast with respect to an embodiment encompassed by Claim 1, there is no teaching or suggestion in Rumreich that control codes should be entirely removed from the user selected portion of closed caption information, as would be necessary such that a relevant search could be made of the user selected words, such as is described on page 10, lines 13-15 of the present application. Because Rumreich is directed different problems than are solved by the claimed invention or by Dey or Chang, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine the teaching of Rumreich with Chang and Dey to derive the claimed invention.

In view that the cited references fail to teach or suggest at least one limitation from each of the above-listed claims and that there is insufficient motivation to combine the references as suggested by the Examiner, Applicant respectfully submits that Claims 1-3, 5-20, 22-26, 28-31, and 33-64 are in condition for allowance.

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CONCLUSION

In light of these remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Respectfully submitted,

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